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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,097	03/08/2000	BENNY MARTIN MATHIESEN	12875.10USWO	1469

23552 7590 02/13/2002

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EXAMINER

GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
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1733

13

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/485097

Applicant(s)

Examiner

Group Art Unit

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12 NOVEMBER 2001.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-13 is/are pending in the application.  
Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-13 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☒ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other FOREIGN REFERENCE TRANSLATION (3)

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1. The substitute specification submitted with the latest amendment has <sup>e</sup>ben placed in the file but is deemed insufficient for proper entry at this time in that (a) there is no statement made that it contains no new matter, as required by MPEP § 608.01(q) - N.B. page 5 lines 14-15 of the amendment; and (b) it is incomplete i.e. only pages 1-7 were supplied.

2. Translations of the three foreign references applied in the last Office action are included as a part of this action for the sake of their completeness of the applicant's file; the most pertinent sections are seen to be as follows: (a) Smuck et al. - page 5 lines 8-13, page 12 lines 19-21 and page 13 lines 12-14; (b) Sumitomo - page 2 last line to page 3 line 5 and page 3 lines 15-17; and (c) Hiraoka - page 5 lines 16-18, page 6 lines 12-17, page 7 lines 3-18 and page 11 lines 6-7.

3. Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, these claims as now presented are seen to be incomplete i.e. claim 1 fails to recite either (a) the laminating conditions (i.e. P, T) employed (N.B. page 11 lines 11-13 of applicant's specification); or (b) that the cooling step in applicant's envisioned process is conducted at or under a high pressure (maintained from the heating step in applicant's process) - N.B. page 8 lines 17-28 and page 11 lines

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21-23 of the specification, such that the cooling cycle or regimen recited in the "wherein" clause (last three lines of this claim) is held to be given no point of reference.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smuck et al. This rejection is adhered to essentially for the reasons of record (see paragraph 7 of the last Office action), with the following being additionally advanced: (a) Applicant's specification (N.B. page 6 lines 14-16 and 26-33) clearly indicates that the cooling pressure roller means constitutes the fixation or fixing means envisioned, which feature is held to be fairly disclosed by Smuck et al., who also provide for CONTROL of both the pressure and heat (or cooling) applied by these means; further, while neither the material worked upon nor the process conditions employed form any part of the (or a) claimed apparatus per se (N.B. Ex parte Thibaut 164 USPQ 666, In re Rishoi et al. 94 USPQ 71 and Ex parte Cullen 132

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USPQ 148), the capability for performing a given function or effect is seen to be structural in nature, such that applicant's disclosed cooling pressure range of 0.1-20 N/mm<sup>2</sup> (which is calculated as corresponding to a pressure of  $2.25 \times 10^4$ - $4.5 \times 10^6$  lb force/m<sup>2</sup>) is seen to involve a structural construction, as indicated above; however, note that the Smuck et al. apparatus applies (i.e. is constructed to be able to apply) a cooling pressure of 100-400 kg/cm<sup>2</sup> (which is calculated as corresponding to a pressure of  $2.2 \times 10^5$ - $8.8 \times 10^5$  lb force/m<sup>2</sup>).

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sumitomo reference in view of Sandt. This rejection is also adhered to essentially for the reasons of record (see paragraph 9 of the last Office action), with the following being additionally advanced: (a) Note that the laminating pressure employed by the Sumitomo reference (viz.

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10 kg/cm<sup>2</sup>) is calculated to correspond to a pressure of  $2.2 \times 10^4$  lb force/m<sup>2</sup>; and (b) in the absence of unexpected results, the choice of the parameters or variables employed to effect the PREFERRED (and presumably beneficial) cooling under pressure technique documented in Sandt is held to be well within the purview of those of ordinary skill in this art to determine and set (i.e. via routine experimentation), which foregoing is in apparent agreement (and consistent with) applicant's specification at page 5 lines 23-25.

8. Applicant's arguments filed 12 November 2001 have been fully considered but they are not deemed to be persuasive. See paragraphs 5-7, above. Finally, with respect to (a) the statement made at page 6 line 18 of the amendment, it is noted that NO SUCH rejection was made by the Examiner; and (b) article-by-process claims 9-1~~7~~<sup>0</sup>, N.B. MPEP § 706.03(e).

9. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

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A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) 305-3599.

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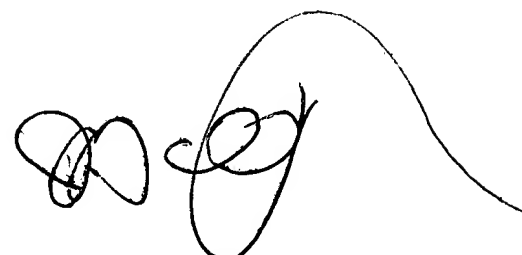
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.

JJGallagher:cdc

January 28, 2002



JOHN J. GALLAGHER  
PRIMARY EXAMINER  
ART UNIT 101 / 733